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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,289	03/16/2004	Bernd-Georg Pietras	MRKS/0028C1	3066
.7590	10/20/2004		EXAMINER	
William B. Patterson			COLLINS, GIOVANNA M	
MOSER, PATTERSON & SHERIDAN, LLP			ART UNIT	PAPER NUMBER
3040 Post Oak Blvd., Suite 1500				3672
Houston, TX 77056				

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/801,289	PIETRAS, BERND-GEORG <i>MW</i>	
	Examiner	Art Unit	
	Giovanna M. Collins	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 13-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 13-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. 09/762,606.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040830</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: In paragraph 001, line 2 the phrase “filed May 21, 2001” should be changed to - - filed May 21, 2001, now U.S. Patent 6,705,405- - .

Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the top drive and the mud pipe with ball joint at ends must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement

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Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 13,14,17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Boyadjieff (4,449,596).

Boyadjieff discloses (see Fig. 2) an apparatus for facilitating making of a connection between an upper tubular and a lower tubular, comprising a top drive (20) having a tubular engagement tool (27); and a suspension unit (see Fig. 11,at 110) operatively connected to the top drive, the suspension unit accommodating movement of the upper tubular.

Referring to claim 14, Boyadjieff discloses the suspension unit (110) includes at least one piston and cylinder to raise and lower the upper tubular.

Referring to claim 17, Boyadjieff discloses suspension unit (110) enables movement of the upper tubular in an axial direction with respect to the tubular to compensate for movement of the upper tubular.

Referring to claim 19, Boyadjieff discloses a mud pipe (57) for delivering mud to the tubulars.

3. Claims 13,14,17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Willis (5,036,927).

Willis discloses (see Fig. 1) an apparatus for facilitating making of a connection between an upper tubular and a lower tubular, comprising a top drive (12) having a tubular engagement tool (30); and a suspension unit (14,28) operatively connected to the top drive, the suspension unit accommodating movement of the upper tubular.

Referring to claim 14, Willis discloses the suspension unit (14,28) includes at least one piston and cylinder (28) to raise and lower the upper tubular.

Referring to claim 17, Willis discloses suspension unit (14,28) enables movement of the upper tubular in an axial direction with respect to the tubular to compensate for movement of the upper tubular.

Referring to claim 19, Willis discloses a mud pipe (22) for delivering mud to the tubulars.

4. Claims 13-18 and 21-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Albright et al. (6,000,472).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Albright discloses (see Fig. 2) an apparatus for facilitating making of a connection between an upper tubular and a lower tubular, comprising a top drive (see col. 10, lines 11-17) having a tubular engagement tool (see fig. 17a, above element 1); and a suspension unit (10) operatively connected to the top drive, the suspension unit accommodating movement of the upper tubular.

Referring to claim 14, Albright discloses the suspension unit (10) includes at least one piston and cylinder (30) to raise and lower the upper tubular.

Referring to claim 15, Albright discloses the suspension unit can be pneumatically actuated to compensate for the weight of the tubular (see col. 9, lines 32-42).

Referring to claims 16, 22 and 27, Albright discloses adjusting the suspension unit to move the upper tubular in at least two planes (see Fig. 17a).

Referring to claim 17, Albright discloses suspension unit (10) enables movement of the upper tubular in an axial direction with respect to the tubular to compensate for movement of the upper tubular.

Referring to claim 18, Albright discloses the suspension unit comprises spherical bearings (see col. 9, lines 21-31).

Referring to claim 21, Albright discloses a method of facilitating making of a connection between an upper tubular and a lower tubular, comprising engaging the upper tubular with a top drive having a suspension unit (see col. 10, lines 11-17); engaging a lower end of the upper tubular with an upper end of the lower tubular (see Figs. 17a-17c); rotating the upper tubular thereby threading the tubular to form the connection; and compensating for movement of the upper tubular with the suspension unit during the threading (see col. 5, lines 55-63).

Referring to claim 23, Albright discloses compensating for movement of the upper tubular comprises pneumatically compensating via at least one piston and cylinder arrangement (see col. 9, lines 33-45).

Referring to claim 24, Albright discloses making of a connection between an upper tubular and a lower tubular, comprising engaging the upper tubular with a top drive having a suspension unit (see col. 10, lines 11-17); compensating for weight the upper tubular to accommodate movement of the upper tubular and engaging a lower end of the upper tubular with an upper end of the lower tubular to form the connection therebetween (see col. 2, lines 32-52).

Referring to claim 25, Albright discloses wherein engaging the lower end of the upper tubular with the upper end of the lower tubular includes rotating the upper tubular, thereby threading the tubulars together (see col. 5, lines 55-59).

Referring to claim 26, Albright discloses comprising compensating for movement of the upper tubular with the suspension unit during the threading (see col. 5, lines 555-63).

Referring to claim 28, Albright discloses compensating for weight of the upper tubular comprises compensating via at least one piston and cylinder arrangement (see col. 9, lines 33-45).

Referring to claim 29, Albright discloses compensating for weight of the upper tubular is pneumatic (see col. 9, lines 33-45).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyadjieff ('596) in view of Myers (4,733,991).

Boyadjieff discloses the apparatus of claim 19 but does not disclose the mud pipe has a ball joint at both ends. Myers teaches a tubular with a ball joint at both ends that permits rotational movement as compensators extend and retract. As it would be advantageous to have rotational movement to correct an misalignment between the tubulars, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus disclosed by Boyadjieff to have ball joints as taught by Myers.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 703-306-5707. The examiner can normally be reached on 6:30-3 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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David Bagnell
Supervisory Patent Examiner
Technology Center 3670